

#10

**CONFIRMATION
COPY**

PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

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IN RE APPLICATION OF : Calabrese, et al. AUG 30 2004

FOR : **APPARATUS, METHOD AND PETITIONS
SYSTEM FOR MAINTAINING CALL
CONTROL AT A GATEWAY MOBILE
SWITCHING CENTER UTILIZING A
PACKET NETWORK**

SERIAL NO.: : 09/558,613

FILED : April 26, 2000

EXAMINER : Rasha S. Al Aubaidi

ART UNIT : 2642

CONFIRMATION NO. : 9462

LAST OFFICE ACTION : July 23, 2004

ATTORNEY DOCKET NO. : LUTZ 2 00133
Case Name/No. Calabrese 10-3-7-16

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AUG 26 2004

**RENEWED PETITION TO ESTABLISH PRIOR RECEIPT IN THE
PATENT AND TRADEMARK OFFICE OF ITEM APPARENTLY
CONSIDERED OMITTED BY THE PATENT AND TRADEMARK OFFICE**

Mail Stop Petition
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Commissioner:

This renewed petition is filed by applicants in response to the Decision on Petition mailed July 23, 2004 for the above-identified patent application. This renewed petition is supplemental to the Petition to Establish Prior Receipt in the Patent and Trademark Office of Item Apparently Considered Omitted by the Patent and Trademark Office filed on June 15, 2004 which was dismissed in the Decision on Petition mailed July 23, 2004.

RESPONSE TO DECISION ON PETITION

Petition's Attorney Douglas I. Wood dismissed the original Petition in a Decision on Petition mailed July 23, 2004. The applicants' patent counsel has had the opportunity to review the decision and to discuss it with Petition's Attorney Wood in a telephone conversation on July 30, 2004.

In support of the decision, Petition's Attorney Wood cites 37 CFR § 1.59(a)(2) which states that "[i]nformation forming part of the original disclosure ... will not be expunged from the application file," MPEP § 724.05(IV) which states that "[a] petition to expunge a part of the original disclosure must be filed under 37 CFR § 1.183, since such a request requires a waiver of the requirements of 37 CFR § 1.59(a)," and 37 CFR § 1.183 which permits suspension of any rules that are not a statutory requirement "in an extraordinary situation, when justice requires states" under the authority of the Director.

Petition's Attorney Wood concluded that the facts presented did not establish an extraordinary situation or special circumstances that require suspension of the rules in the interests of justice. In support of this conclusion, Petition's Attorney Wood found that, according to the Patent and Trademark Office (PTO) file, 35 pages of specification, including 54 claims and one (1) page of abstract, were filed on April 26, 2000 and an absence of convincing evidence (e.g., a postcard receipt under MPEP § 503 containing specific itemization of the document(s) or fee(s) purported to have been filed with the correspondence at issue) that the PTO received and misplaced any document(s) or fee(s) that is not among the official records of the PTO.

In the telephone conversation, applicants' counsel pointed out that Exhibit 6 to the original petition was a return postcard that was returned to the Patent Attorney that originally filed the application and that the return postcard was itemized to reflect that the originally-filed specification, claims, and abstract was 30 pages. Petition's Attorney Wood acknowledged that Exhibit 6 was in the file and invited us to submit a renewed petition. He also stated that, rather than re-submitting the exhibits, the renewed petition could refer to the exhibits provided in the original petition.

In the telephone conversation, concerns regarding expungement raised in the decision were discussed. Petition's Attorney Wood stated that

expungement of the 30-page specification, claims, and abstract may be impossible. Applicants' counsel pointed out that, even though expungement was requested, the applicants were interested in simply making sure that any patent issued from this application did not include the 35-page specification, claims, and abstract. From this discussion, the applicants now understand that the 35-page specification, claims, and abstract may be retained in the PTO file, even if the petition is granted. However, if the petition is granted, there would be some indication that the 35-page specification, claims, and abstract was replaced by the 30-page specification, claims, and abstract and that the 30-page specification, claims, and abstract was recognized as the originally-filed specification, claims, and abstract. For example, in the hard copy of the file the 35-page specification, claims, and abstract may be placed at the back of the file and turned around so that the pages faced backward if the petition were granted. Based on this discussion, in the renewed petition below, the applicants request that the 35-page specification, claims, and abstract be canceled or deleted (and treated as noted above) from the currently-pending application rather than expunged from the PTO record.

Based on the foregoing and the renewed petition provided herein, the applicants respectfully request Petition's Attorney Wood to reconsider dismissal of the petition and to grant the items requested below in the renewed petition.

RENEWED PETITION

The applicants file this renewed petition to respectfully invoke the supervisory authority of the PTO under 37 CFR §§1.181(a)(3), 1.182, and/or 1.183. The Commissioner is respectfully requested to:

- i) order the originally-filed 30-page specification, claims, and abstract be entered into the file history maintained at the PTO,
- ii) order the 35-page specification, claims, and abstract currently found in the file history maintained at the PTO be canceled or otherwise deleted from the currently-pending application,
- iii) order the above-identified patent application to continue to be accorded the original April 26, 2000 filing date after these actions, and

iv) order the pending Office Action mailed March 15, 2004 for the above-identified patent application be vacated or otherwise withdrawn.

The applicant finds MPEP §601.01(d) and 37 CFR §1.53(e) useful as guidelines for this situation, even though this initiative did not originate as a response to a "Notice of Incomplete Application" or "Notice of Omitted Items" from the PTO. The Exhibits referred to below are found in the original petition filed on June 15, 2004.

Statement of Facts

The above-identified patent application was filed on April 26, 2000 by Nancy R. Gamburd, Reg. No. 38,147, Patent Attorney, of Gamburd & Associates, Ltd. via Express Mail No. EK429074425US. This Express Mail package included:

- i) a transmittal cover letter (Exhibit 1),
- ii) a specification, claims, and abstract (Exhibit 2),
- iii) a set of informal drawings (Exhibit 3),
- iv) an executed declaration and power of attorney (Exhibit 4),
- v) an executed assignment and cover sheet (Exhibit 5), and
- vi) a return postcard (Exhibit 6).

The originally-filed specification, claims, and abstract (Exhibit 2) was 30 pages as indicated on the transmittal cover letter (Exhibit 1) and the return postcard (Exhibit 6). Additionally, the originally-filed specification and abstract (Exhibit 2) is entitled "Apparatus, Method and System for Maintaining Call Control at a Gateway Mobile Switching Center Utilizing a Packet Network" as indicated on the transmittal cover letter (Exhibit 1), executed declaration and power of attorney (Exhibit 4), executed assignment and cover sheet (Exhibit 5), and return postcard (Exhibit 6).

Receipt of the Express Mail package was confirmed when the return postcard (Exhibit 6) was received by Attorney Gamburd. The return postcard (Exhibit 6) includes a PTO label indicating that serial no. 09/558,613 was assigned to the above-identified patent application and that April 26, 2000 was the filing date. The return postcard (Exhibit 6) is postmarked May 2, 2000. Notably, the "specification, claims, and abstract (30 pages)" item on the return postcard (Exhibit

6) is not annotated. This indicates that the originally-filed 30-page specification, claims, and abstract (Exhibit 2) was received by the PTO.

Exhibits 1-6 were copied from the historical records for this patent application maintained by outside counsel for Lucent. A declaration by Attorney Gamburd (Exhibit 7) confirms the foregoing facts and provides additional support that Exhibit 2 is the originally-filed 30-page specification, claims, and abstract for patent application serial no. 09/558,613, filed on April 26, 2000.

European patent application no. 01303679.3, entitled "Apparatus, Method and System for Maintaining Call Control at a Gateway Mobile Switching Center Utilizing a Packet Network," was filed on April 23, 2001 by Lucent. This European application was published on Oct. 31, 2001 as document no. EP 1 150 522 (Exhibit 8). The applicant (i.e., Lucent) claimed priority to U.S. patent application serial no. 558,613, filed on April 26, 2000. When comparing the specifications, claims, and abstracts of Exhibits 2 and 8, one finds that paragraph numbers were added in Exhibit 8 and that the number of claims was reduced from 56 claims in Exhibit 2 to 32 claims in Exhibit 8. Nevertheless, one recognizes that the originally-filed 30-page specification, claims, and abstract (Exhibit 2) was filed in the European Patent Office on April 23, 2001 because the same text in the specification, claims, and abstract of Exhibit 8 is also found in Exhibit 2. Since the European application was published in 2001 (more than one year before 2004), the applicants face time bar issues under 35 U.S.C. §102(b) regarding re-filing the originally-filed 30-page specification, claims, and abstract to obtain a new filing date. Due to these special circumstances, this is an extraordinary situation for which the petitions attorney may suspend any conflicting rules in the interest of justice to provide an equitable solution to the applicants.

On October 29, 2002, the applicants filed an associate power of attorney and change of correspondence address (Exhibit 9) with the PTO for the above-identified patent application in conjunction with transfer of patent prosecution from Gamburd & Associates to Fay, Sharpe, Fagan, Minnich & McKee, LLP (Fay Sharpe), 1100 Superior Avenue, Seventh Floor, Cleveland, OH 44114-2518. On November 8, 2002, the PTO mailed a corrected filing receipt (Exhibit 10) to the applicants showing Fay Sharpe's correspondence address.

On November 26, 2002, the applicants filed a request for corrected filing receipt (Exhibit 11) with the PTO. The request pointed out: i) that inventor

Hudepohl's name was spelled wrong, ii) that the total number of claims should be 56, rather than 54, iii) that the number of independent claims should be five (5), rather than four (4), and iv) that the filing fee received should be \$1494, rather than \$1380. In response, on December 16, 2002, the PTO mailed a corrected filing receipt and a response to the request for a corrected filing receipt (Exhibit 12) to the applicants. The corrected filing receipt (Exhibit 12) showed Inventor Hudepohl's name spelled correctly. The response to the request for a corrected filing receipt (Exhibit 12) indicated that the number of claims (i.e., 54 total claims and four (4) independent claims) and the filing fee (i.e., \$1380) reflected on the earlier filing receipt was correct. The PTO explained that the number of claims (i.e., 56 total claims and five (5) independent claims) and the filing fee (i.e., \$1494) identified in the request for a corrected filing receipt (Exhibit 11) was a miscalculation by the applicants. Notably, the filing receipts (Exhibits 10 and 12) both showed the correct number of drawings (see Exhibits 1, 2, 3, and 6), the correct applicants (see Exhibits 1, 4, 5, and 6), and the correct title (see Exhibits 1, 2, 4, 5, and 6). At that time, the applicants had reason to believe that this minor discrepancy related to the number of claims could be resolved with an Examiner after an Office Action was issued. The applicants had no reason to believe, at that time, that the specification, claims, and abstract in the file history maintained by the PTO was not the originally-filed 30-page specification, claims, and abstract (Exhibit 2) from this minor discrepancy. Indeed, once a filing receipt was issued for the above-identified patent application, it was reasonable for the applicants to believe that the Office of Initial Patent Examination (OIPE) had:

- i) confirmed that the title on the specification, claims, and abstract in the file history maintained by the PTO matched the title identified in the transmittal cover letter (Exhibit 1) and executed declaration and power of attorney (Exhibit 4) and

- ii) confirmed that the specification, claims, and abstract in the file history maintained by the PTO were consistent with the drawings (Exhibit 3).

On March 15, 2004, the PTO mailed a first Office Action (Exhibit 13) on the above-identified patent application to the applicants. This Office Action (Exhibit 13) indicated that claims 1-54 were pending in the application and discussed various grounds for rejection. Referring now to Exhibit 15, Alan C.

Brandt, Reg. No. 50,218, Patent Attorney, of Fay Sharpe began reviewing the Office Action (Exhibit 13) in April 2004. Attorney Brandt noticed that the grounds for rejection referred to specific language in the claims and that the same specific language could not be found in the claims of the originally-filed 30-page specification, claims, and abstract (Exhibit 2). Additionally, Attorney Brandt found a discrepancy between the Office Action (Exhibit 13) and the originally-filed 30-page specification, claims, and abstract (Exhibit 2) as to the total number of claims pending. There were 56 total claims in the originally-filed 30-page specification (Exhibit 2) and the Office Action (Exhibit 13) indicated that only 54 claims were pending. The Office Action (Exhibit 13) stated that any inquiries concerning PTO communications for the above-identified patent application should be directed Examiner Rasha S AL-Aubaidi or Supervisory Patent Examiner Ahmad Matar.

With continuing reference to Exhibit 15, on April 7, 2004, Attorney Brandt contacted Examiner AL-Aubaidi by telephone to discuss this matter. Attorney Brandt and Examiner AL-Aubaidi compared claim 1 from the specification, claims, and abstract in the file history maintained at the PTO to claim 1 in the originally-filed 30-page specification, claims, and abstract (Exhibit 2) and found that they were not the same. Attorney Brandt and Examiner AL-Aubaidi also compared the total number of claims in the specification, claims, and abstract in the file history maintained at the PTO to the total number of claims in the originally-filed 30-page specification, claims, and abstract (Exhibit 2) and found that they were not the same. There were 54 total claims in the specification, claims, and abstract in the file history maintained at the PTO and 56 total claims in the originally-filed 30-page specification, claims, and abstract (Exhibit 2). Attorney Brandt and Examiner AL-Aubaidi agreed to discuss this matter further after each had an opportunity to investigate their respective files.

On April 12, 2004 Attorney Brandt and Examiner AL-Aubaidi discussed this matter again via telephone. Examiner AL-Aubaidi indicated that she had not found anything in the file history maintained at the PTO to explain the problem. Attorney Brandt indicated that he had not found anything in the historical records maintained by outside counsel for this patent application that might explain why the claims from the originally-filed 30-page specification, claims, and abstract were not in the PTO's file. Attorney Brandt indicated that he had found U.S. Pat. No. 6,307,929, Serial No. 09/558,578 (Exhibit 14). Attorney Brandt also indicated that

the '929 patent (Exhibit 14): i) includes claims that seem to match up to the specific language referred to in the Office Action (Exhibit 13), ii) was filed on April 26, 2000, iii) was issued on October 23, 2001, and iv) was assigned on its face to Lucent. Attorney Brandt requested that Examiner AL-Aubaidi check the number of pages in the specification, claims, and abstract in the file history maintained at the PTO. Examiner AL-Aubaidi indicated that there were 35 pages in the specification, claims, and abstract in the file history maintained at the PTO. Attorney Brandt indicated that there were 30 pages in the originally-filed specification, claims, and abstract (Exhibit 2). Attorney Brandt and Examiner AL-Aubaidi discussed the title on the specification, claims, and abstract in the file history maintained by the PTO and found that it was the same as the title on the '929 patent (Exhibit 14). The title for both was found to be "Apparatus, Method and System for Providing Conditional Answering in Multiple Leg Telecommunication Sessions." Notably, the title on the originally-filed 30-page specification, claims, and abstract (Exhibit 2) is "Apparatus, Method, and System for Maintaining Call Control at a Gateway Mobile Switching Center Utilizing a Packet Network." Examiner AL-Aubaidi requested that Attorney Brandt fax the claims from the originally-filed 30-page specification, claims, and abstract (Exhibit 2) to her so she could discuss this matter with Supervisor Matar.

On April 15, 2004, Supervisor Matar and Examiner AL-Aubaidi contacted Attorney Brandt by telephone. Examiner AL-Aubaidi indicated that she had not found the originally-filed claims faxed to her in the file history maintained at the PTO or in any patent application file that she thought might have been related. Supervisor Matar and Examiner AL-Aubaidi indicated that they had compared the application in the file history maintained at the PTO for the above-identified patent application with the '929 patent (Exhibit 14) and that the specification and claims appeared to be the same, but that the drawings were different. Attorney Brandt informed Supervisor Matar and Examiner AL-Aubaidi that the historical records maintained by outside counsel included a return postcard (Exhibit 6) from the PTO indicating that a 30-page specification, claims, and abstract was received by the PTO and that Examiner AL-Aubaidi had indicated that the specification, claims, and abstract in the file history maintained at the PTO was 35 pages. Attorney Brandt asked Supervisor Matar if he would enter the originally-filed 30-page specification, claims, and abstract into the record. Supervisor Matar indicated that he could not grant the original filing date to any specification, claims, and abstract submitted now

and that this would be a matter for the Petitions Office to decide. Thus, since April 15, 2004, the applicants have taken a course of action to fully investigate this matter and prepare the original petition and this renewed petition.

A declaration by Attorney Brandt (Exhibit 15) confirms the foregoing facts of April 2004 and provides additional support for when this matter was identified and when the applicants became aware that it would be necessary to prepare the original petition.

The applicants obtained a copy of the file history maintained at the PTO for the above-identified patent application in May 2004. The PTO file history included: i) a transmittal cover letter (Exhibit 16), ii) a 35-page specification, claims, and abstract (Exhibit 17), iii) a set of informal drawings (Exhibit 18), and iv) an executed declaration and power of attorney (Exhibit 19). Notably, the transmittal cover letter (Exhibit 16), set of informal drawings (Exhibit 18), and executed declaration and power of attorney (Exhibit 19) from the PTO file history match the corresponding originally-filed transmittal cover letter (Exhibit 1), set of informal drawings (Exhibit 3), and executed declaration and power of attorney (Exhibit 4). However, the 35-page specification, claims, and abstract (Exhibit 17) from the PTO file history does not match the originally-filed 30-page specification, claims, and abstract (Exhibit 2). We also note that the title on pages 1 and 35 of the 35-page specification, claims, and abstract (Exhibit 17) from the PTO file history does not match the title on the transmittal cover letter (Exhibit 16) and executed declaration and power of attorney (Exhibit 19) from the PTO file history. Moreover, pages 6 and 7 of the 35-page specification, claims, and abstract (Exhibit 17) from the PTO file history identify Figures 1A, 1B, 1C, 2, 3, 4, and 5, while the set of informal drawings (Exhibit 18) from the PTO file history provide Figures 1, 2, 3, 4, 5, 6, and 7.

Points to be Reviewed

The applicants respectfully request review of the evidence presented herein showing that the specification, claims, and abstract currently found in the file history maintained at the PTO for the above-identified patent application is not the originally-filed 30-page specification, claims, and abstract and showing that the originally-filed 30-page specification, claims, and abstract was received by the PTO. Additionally, the applicants respectfully request review of the validity of the first

Office Action mailed March 15, 2004 which is based on the wrong specification, claims, and abstract.

Action Requested

The applicants respectfully request the following actions:

i) order the originally-filed 30-page specification, claims, and abstract be entered into the file history maintained at the PTO,

ii) order the 35-page specification, claims, and abstract currently found in the file history maintained at the PTO be canceled or otherwise deleted,

iii) order the above-identified patent application to continue to be accorded the original April 26, 2000 filing date after these actions, and

iv) order the pending Office Action mailed March 15, 2004 for the above-identified patent application be vacated or otherwise withdrawn.

Payment of Fee

Applicants hereby submit the \$130 petition fee required under 37 CFR §1.17(h) to the PTO for consideration of this renewed petition.

Authorization is hereby made to charge the amount of \$130 to Deposit Account No. 06-0308.

The Commissioner is hereby authorized to charge any additional fees and credit any overpayment to Deposit Account No. 06-0308.

It is respectfully requested that, upon grant of the renewed petition, the petition fees associated with the original petition and this renewed petition be refunded by a credit to the charge authorized above.

Respectfully submitted,
FAY, SHARPE, FAGAN
MINNICH & McKEE, LLP



Joseph D. Dreher, Reg. No. 37,123
1100 Superior Ave., 7th Floor
Cleveland, Ohio 44114
Tel. (216) 861-5582
Fax (216) 241-1666

CERTIFICATE OF MAILING

- I certify that this Petition for Extension of Time Under 37 C.F.R. 1.136(a) is being
- ☐ deposited with the United States Postal Service as First Class mail under 37 C.F.R. § 1.8, addressed to: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on the date indicated below.
 - ☒ transmitted via facsimile (703-872-9306) under 37 C.F.R. § 1.8 on the date indicated below.
 - ☐ deposited with the United States Postal Service "Express Mail Post Office to Addressee" service under 37 C.F.R. 1.10 on the date indicated below and is addressed to: MAIL STOP PETITION, Commissioner For Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

Express Mail Label No.:
Date <i>August 13, 2004</i>

Signature <i>Roseanne Giuliani</i>
Printed Name Roseanne Giuliani

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FAY, SHARPE, FAGAN, MINNICH & MCKEE, LLP**RECEIVED****AUG 30 2004****OFFICE OF PETITIONS**

PATENT TRADEMARK AND COPYRIGHT LAW

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DATE: August 26, 2004

TO: USPTO - Art Unit 2642

ATTN.: Douglas I. Wood

FACSIMILE NO.: (703) 872-9306

FROM: Joseph D. Dreher

RE: App. Ser. No.: 09/558,613 Our Ref.: LUTZ 2 00133

TOTAL PAGES: 12 (including cover sheet)

Please call us immediately at (216) 861-5582 if this transmission is incomplete or illegible.

COMMENTS

We noted our original facsimile on August 13, 2004 was to the attention of Examiner Rasha S. Al Aubaidi at facsimile no. (703) 872-9306.

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